

**REMARKS**

This request for reconsideration is being filed in response to the Office Action dated November 7, 2008. For the following reasons this application should be allowed and the case passed to issue.

Claims 1-15 are pending in this application. Claim 15 was withdrawn in view of a restriction requirement. Claims 1-14 were rejected.

***Restriction***

The restriction requirement was made final in the Office Action. It is clear from the rationale provided that the Office does not appreciate the requirements for restriction in an application filed under 35 U.S.C. § 371. The Office Action's rationale for the restriction is clearly improper. The Office Action asserted that claim 1 is an apparatus, which is a completely different statutory class than claim 15. However, different statutory class is not a relevant factor in reaching a conclusion whether claims are restrictable in 371 application. Furthermore, the Office Action alleged that the only common technical feature among claims 1 and 15 is "the antifreeze mechanism," which was "already shown to applicants in EP 1036996." Firstly, EP 1036996 has not been properly cited in this application, as it has not been cited on a PTO-892 form and a copy has not been provided to Applicant. If the Office believes EP 1036996 is relevant to the present claims then the Office should cite it on a PTO-892 form and provide a copy of the reference to Applicant. Secondly, the Office apparently ignored the explanation of the special technical feature provided in the Response to Restriction filed September 17, 2008. The Office is not free to arbitrarily select a feature and decree it as the special technical feature just because it might be taught in the prior art, and then use that as a basis for imposing a restriction requirement.

Claim 1 requires a sensor which detects a parameter for estimating a freezing probability of water in the fuel cell power plant after operation of the fuel cell power plant stops. The corresponding technical feature in claim 15 is the step of detecting a parameter for estimating a freezing probability of water in the fuel cell power plant after operation of the fuel cell power plant stops.

Claim 1 further requires a programmable controller programmed to estimate the freezing probability of water in the fuel cell power plant after operation of the fuel cell power plant has stopped based on the parameter. The corresponding technical feature in claim 15 is estimating the probability of water freezing in the fuel cell power plant after operation of the fuel cell power plant has stopped based on the parameter. The programmable controller of claim 1 is further programmed to estimate a wait time from when the power plant has stopped operating based on the freezing probability. The corresponding technical feature in claim 15 is estimating a wait time from when the power plant has stopped operating based on the freezing probability. The programmable controller of claim 1 also is programmed to suspend operation of the antifreeze mechanism until the wait time has elapsed from when the fuel cell power plant stops operating. The corresponding technical feature in claim 15 is suspending operation of the antifreeze mechanism until the wait time has elapsed from when the fuel cell power plant stops operating. Thus, the clearly improper restriction requirement is strongly traversed, and reconsideration thereof respectfully requested. Claim 15 should be examined along with claims 1-14.

***Claim Rejections Under 35 U.S.C. § 102***

Claims 1-8, 11, and 14 were rejected under 35 U.S.C. § 102(b) as being clearly anticipated by Bonville (US 6,248,462). This rejection is traversed, and reconsideration and

withdrawal thereof respectfully requested. The following is a comparison between the present invention, as claimed, and the cited prior art.

The Office Action asserted that Bonville teaches a fuel cell plant having an antifreeze mechanism which comprises a heater, a temperature sensor, and a programmable controller.

Bonville does not anticipate claims 1 and 14 because Bonville does not disclose a programmable controller programmed to: estimate a freezing probability of water in the fuel cell power plant after operation of the fuel cell power plant has stopped based on the parameter, estimate a wait time from when the power plant has stopped operating based on the freezing probability, suspend operation of the antifreeze mechanism until the wait time has elapsed from when the fuel cell power plant stops operating, as required by claim 1; and means for estimating a freezing probability of water in the fuel cell power plant after operation of the fuel cell power plant stops, means for estimating a wait time from when the power plant has stopped operating based on the freezing probability, and means for suspending operation of the antifreeze mechanism until the wait time has elapsed from when the fuel cell power plant stops operating, as required by claim 14.

The Office apparently believes that because the controller of Bonville may be capable of being programmed to perform the above steps, that Bonville anticipates the present claims.

Contrary to the Office's apparent assumption, it is well settled law that a programmed controller is patentably distinct from an unprogrammed controller.

If a machine is programmed in a certain new and unobvious way, it is physically different from a machine without that program; its memory elements are differently arranged. The fact that these physical changes are invisible to the eye should not tempt us to conclude that the machine has not been changed. If a new machine has not been invented, certainly a "new and useful improvement" of the unprogrammed machine has been, and Congress has said in 35 U.S.C. § 101 that such improvements are statutory subject matter for a patent.

*In re Bernhart*, 417 F.2d 1395 (C.C.P.A. 1969).

The Office Action relied on MPEP § 2114 as allegedly supporting its position. According to MPEP § 2114, “[w]hile features of an apparatus may be recited either structurally or functionally, claims directed to an apparatus must be distinguished from the prior art in terms of structure rather than function.” *In re Schreiber*, 128 F.3d 1473, 1477-78, 44 USPQ2d 1429, 1431-32 (Fed. Cir. 1997). Further, “[a] claim containing a “recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus” if the prior art apparatus teaches all the structural limitations of the claim. *Ex parte Masham*, 2 USPQ2d 1647 (Bd. Pat. App. & Inter. 1987). As is clear from the *Bernhart* decision, the programmable controller of the present claims is structurally distinct from the prior art controller, as its memory elements are differently arranged. Therefore, Bonville does not disclose all the claimed structural limitations and does not anticipate claims 1 and 14.

The factual determination of lack of novelty under 35 U.S.C. § 102 requires the disclosure in a single reference of each element of a claimed invention. *Helifix Ltd. v. Blok-Lok Ltd.*, 208 F.3d 1339, 54 USPQ2d 1299 (Fed. Cir. 2000); *Electro Medical Systems S.A. v. Cooper Life Sciences, Inc.*, 34 F.3d 1048, 32 USPQ2d 1017 (Fed. Cir. 1994); *Hoover Group, Inc. v. Custom Metalcraft, Inc.*, 66 F.3d 399, 36 USPQ2d 1101 (Fed. Cir. 1995); *Minnesota Mining & Manufacturing Co. v. Johnson & Johnson Orthopaedics, Inc.*, 976 F.2d 1559, 24 USPQ2d 1321 (Fed. Cir. 1992); *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051 (Fed. Cir. 1987). Because Bonville does not disclose a programmable controller programmed to: estimate a freezing probability of water in the fuel cell power plant after operation of the fuel cell power plant has stopped based on the parameter, estimate a wait time from when the power plant has stopped operating based on the freezing probability, suspend

operation of the antifreeze mechanism until the wait time has elapsed from when the fuel cell power plant stops operating, as required by claim 1; and means for estimating a freezing probability of water in the fuel cell power plant after operation of the fuel cell power plant stops, means for estimating a wait time from when the power plant has stopped operating based on the freezing probability, means for suspending operation of the antifreeze mechanism until the wait time has elapsed from when the fuel cell power plant stops operating, as required by claim 14, Bonville does not anticipate claims 1 and 14.

Applicant further submits that Bonville does not suggest the claimed fuel cell power plants.

***Claim Rejections Under 35 U.S.C. § 103***

Claims 9 and 10 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Bonville in view of Komura (US 6,242,119).

Claims 12 and 13 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Bonville in view of Yoshizawa (US 2003/0003334).

These rejections are traversed, and reconsideration and withdrawal thereof respectfully requested.

Bonville, Komura, and Yoshizawa, whether taken alone, or taken in combination, do not suggest the claimed fuel cell power plant because Komura and Yoshizawa do not cure the deficiencies of Bonville. Komura and Yoshizawa do not suggest a programmable controller programmed to: estimate a freezing probability of water in the fuel cell power plant after operation of the fuel cell power plant has stopped based on the parameter, estimate a wait time from when the power plant has stopped operating based on the freezing probability, and suspend

**Application No.: 10/520,082**

operation of the antifreeze mechanism until the wait time has elapsed from when the fuel cell power plant stops operating, as required by claim 1.

The dependent claims are allowable for at least the same reasons as claim 1 and further distinguish the claimed fuel cell power plant.

In view of the above amendments and remarks, Applicant submits that this amendment should be entered, the application allowed, and the case passed to issue. If there are any questions regarding this Amendment or the application in general, a telephone call to the undersigned would be appreciated to expedite the prosecution of the application.

To the extent necessary, a petition for an extension of time under 37 C.F.R. § 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 500417 and please credit any excess fees to such deposit account.

Respectfully submitted,

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